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In The

# Supreme Court of the United States

October Term, 1994

QUALITEX COMPANY,

*Petitioner,*

v.

JACOBSON PRODUCTS CO., INC.,

*Respondent.*

**On Writ Of Certiorari**
**To The United States Court Of Appeals**
**For The Ninth Circuit**

## BRIEF AMICUS CURIAE IN SUPPORT OF PETITIONER

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**Lackenbach Siegel Marzullo Aronson & Greenspan, P.C. ("Lackenbach Siegel") respectfully submits this brief *amicus curiae* in support of the Petitioner. Lackenbach Siegel has obtained the express written permission of Petitioner, Qualitex Co., and the Respondent, Jacobson Co., to file this brief *amicus curiae*. The judgment of the United States Court of Appeals for the Ninth Circuit ("Ninth Circuit") in *Qualitex Co. v. Jacobson Products Co.*, 13 F.3d 1297 (9th Cir. 1994) which holds that color *alone* does not constitute a registrable trademark under the Lanham Act should be reversed.**

## INTEREST OF THE *AMICUS CURIAE*

**Lackenbach Siegel** presents this brief *amicus curiae* on behalf of members of the prestigious Hand Tools Institute[1] and American hand tool manufacturers, in

[1] The members of the Hand Tools Institute include Channellock, Inc. of Meadville, Pennsylvania; Coopertools of Raleigh, North Carolina; SK Hand Tool Corporation of Chicago, Illinois; Greenlee Textron, Inc. of Rockford, Illinois; Warren Tool Corporation of Garrettsville, Ohio; Ridge Tool Company; Hyde Manufacturing Company of Southbridge, Massachusetts; Bondhus Corporation of Monticello, Minnesota; Vaughan & Bushnell Manufacturing Co. of Hebron, Illinois; Stanley Tools, Division of the Stanley Works of New Britain, Connecticut; Vermont American Corporation of Lincolnton, North Carolina; A. & E. Manufacturing Company of Racine, Wisconsin; Wilton Tool Division of Wilton Corporation of Schiller Park, Illinois; Danaher Tool Group of Lancaster, Pennsylvania; Klein Tools, Inc. of Chicago, Illinois; Red Devil, Inc. of Union, New Jersey; Stride Tool, Inc. of Little Valley, New York; Snap-On Tools Corporation of Kenosha, Wisconsin; Wright Tool Company; and, Zephyr Manufacturing Company.

particular, Channellock, Inc., Central Tools, Inc., Hyde Manufacturing Company, Inc., Magnetic Tool Organizers, Inc., Mueller Electric Company, Inc., Russell Harrington Cutlery, Inc., Vaughan & Bushnell Manufacturing Company, and Waekon Industries, Inc.[2]

These members of the American hand tool industry and other related industries enjoy substantial goodwill and renown for their hand tool products that include color trademarks. Of particular interest to these manufacturers is the protection of their goods in the domestic and international markets. The Ninth Circuit's holding that color *alone* does not constitute a registrable trademark under 15 U.S.C. § 1051, *et seq.*, impedes these manufacturers' ability to enforce common law and federal trademark rights in their unique color marks. Without redress by this Court, these American companies, employing hundreds, if not thousands, of people, would not be able to enforce their color trademarks uniformly throughout the United States against domestic and international competition. Therefore, the Ninth Circuit's decision and the decision of the Seventh Circuit denying the registrability of color *alone* impairs the ability of these manufacturers to uniformly protect their trademark rights.

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[2] This brief should not be interpreted to reflect the views of any particular member.



## SUMMARY OF THE ARGUMENT

The plain meaning of the term "trademark" in the Lanham Act does not preclude the registration of a color *alone* when it functions as a trademark. Notwithstanding the plain meaning of the statute, the legislative history of the Trademark Law Revision Act of 1988 clearly expresses Congress' intent not to preclude the registration of color *alone* when it functions as a trademark. Several policy reasons support the registration of color *alone*. In particular, United States trademark law should not be interpreted to exclude the registration of color *alone* so as to impede global trademark law harmonization efforts, and to place American business at a disadvantage against foreign competitors in the United States and abroad.

A single color trademark is no different than a standard word or design trademark. Just as for word or design trademarks, there exists millions of distinct and arbitrary color trademarks. The color depletion theory is anachronistic due to advances in color processing technology. As such, the color depletion theory cannot serve as a policy basis for prohibiting the registration of a color trademark under the Lanham Act. Additionally, the shade confusion theory cannot serve as a basis for prohibiting the registration of a color under the Lanham Act on the grounds that the test for likelihood of confusion for word or design marks is analogous to the test for shade confusion for color marks.

For the foregoing reasons, color *alone* when it functions as a trademark should not be precluded from registration under the Lanham Act.

## ARGUMENT

### REASONS FOR REVERSAL OF THE NINTH CIRCUIT DECISION

### I. THE PLAIN MEANING OF THE TERM "TRADEMARK" IN THE LANHAM ACT DOES NOT PROHIBIT THE REGISTRATION OF A COLOR *ALONE* AS A TRADEMARK.

The plain meaning of the definition of the term "trademark" in the Lanham Act does not prohibit the registration of a color *alone* as a trademark. The starting point for the interpretation of a statute is the language of the statute itself. Absent a clearly expressed legislative intention to the contrary, the language must ordinarily be regarded as conclusive. *Kaiser Aluminum and Chemical Corp. v. Bonjorno*, 494 U.S. 827, 835 (1990). The Lanham Act states: "No *trademark* by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature *unless* it falls into the categories listed in sub-sections (a) through (e)." 15 U.S.C. § 1052 (Emphasis added.).

Where the language of a statute is literally **exclusive**, there is no basis for creating an exclusion not literally authorized by the statute. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 112 S. Ct. 2753, *reh'g denied*, 113 S. Ct. 20 (1992); *Venegas v. Mitchell*, 495 U.S. 82 (1990). 15 U.S.C. § 1052 specifically refuses the registration of trademarks on the Principal Register that fall into categories (a) through (e). A color *alone* is not a trademark that falls in categories (a) through (e) of 15 U.S.C. § 1052. Thus, since the statute does not literally exclude a color *alone* from registration,



there is no basis for creating an exclusion not literally authorized by the statute.

Where the language of a statute is literally **inclusive**, there is no basis for creating an exclusion not literally authorized by the statute. *California v. American Stores, Inc.*, 495 U.S. 271 (1990); *United States v. Energy Resources Co.*, 495 U.S. 545 (1990) (The literal absence of a limitation in the statutory language is a conclusive argument for not creating such a limitation.). The Lanham Act is worded in relevant part:

> [N]othing herein shall prevent the registration of a **mark** used by the applicant which has become distinctive of the applicant's goods in commerce.

15 U.S.C. § 1052(f) (Emphasis added.).

> The term "trademark" includes any word, name, **symbol, or device, or any combination thereof** – (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the Principal Register established by this Act, **to identify and distinguish** his or her goods, including a unique product, from those manufactured or sold by others and **to indicate the source of the goods**, even if that source is unknown."

15 U.S.C. § 1127 (Emphasis added.). The definition of the term "trademark" includes any **"symbol, or device."** A symbol, in its ordinary meaning, is "something that stands for or represents another thing; esp. an object used to represent something abstract." *Webster's New World Dictionary* 1442 (2nd College Ed. 1979). A color *alone*, when it functions as a trademark, represents another

thing, namely, the source or origin of a product. Thus, a color *alone* is a symbol. The language of the statute is literally inclusive of a color *alone* as a symbol, and, as such, a trademark. There is no basis for creating an exclusion not literally authorized by the statute.

## II. NOTWITHSTANDING THE PLAIN MEANING OF THE LANHAM ACT, THE LEGISLATIVE HISTORY OF THE TRADEMARK LAW REVISION ACT OF 1988 EXPRESSES CONGRESS' INTENT NOT TO PRECLUDE COLOR *ALONE* FROM REGISTRATION.

The legislative history of the Trademark Law Revision Act of 1988 expresses Congress' intent not to prohibit color *alone* from registration under the Lanham Act. "If the intent of Congress is clear, that is the end of the matter; for the court, as well as [an] agency must give effect to the unambiguous intent of Congress." *Chevron, U.S.A. Inc. v. National Resources Defense Council, Inc.*, 467 U.S. 837, 842-843, *reh'g denied*, 468 U.S. 1227 (1984).

The intent of Congress in adopting the Trademark Law Revision Act of 1988 is unequivocal. Senator DeConcini, in introducing Senate Bill 1883, declared in relevant part:

> This legislation is designed to bring the 41-year-old Lanham Act up to date with present day business and commercial practices and realities, to increase the value of the Federal Trademark Registration System for U.S. companies, [and] to continue the protection of the public from counterfeit, confusion and deception . . .



> Two years ago the U.S. Trademark Association formed the Trademark Review Commission to conduct a comprehensive review, analysis, and debate of the policies and components of the trademark system. That process included an exhaustive questionnaire to the trademark community, extensive study of specific topics by committees, and open debate at annual meetings. The Commission produced a lengthy report of its findings and recommended legislative changes in the trademark system. **The bill I am introducing today is *based on the Commission's report and recommendations.***

133 Cong. Rec. S16,546 (daily ed. Nov. 19, 1987) (Emphasis added. Remarks on the Introduction of S1883 by Sen. DeConcini.).

During the first Senate debate, Senator DeConcini confirmed Congress' intent:

> Mr. President, S. 1883, the Trademark Law Revision Act of 1988, represents the culmination of thousands of hours of work over the past 2½ years. The bill is based on the results of a study conducted by the U.S. Trademark Association's Review Commission. The Commission's comprehensive review of the policies and components of the trademark system included an exhaustive questionnaire to the trademark community, extensive study of specific topics by committee, and an open debate at annual meetings. Hundreds of trademark owners and practitioners, more than 50 organizations, government officials in the United States and abroad, and eminent scholars in the fields of constitutional, commercial, trademark and unfair competition law contributed their views. When the study

> was completed, the Commission produced a lengthy report of its findings and recommended legislative changes in the trademark system. **S. 1883, as I introduced it on November 19, 1987, encompassed those *recommendations*.**

134 Cong. Rec. S5,868 (daily ed. May 13, 1988) (Emphasis added. Remarks on S. 1883 by Sen. DeConcini at the First Senate Debate on the Trademark Law Revision Act of 1988.).

The U.S. Trademark Association Trademark Review Commission's Final Report unequivocally **recommended**:

> The terms "**symbol**, or **device**" should not be deleted or narrowed to preclude registration of such things as **a color**, shape, smell, sound or configuration **which functions as a mark**. The Commission does not intend to limit in any way the subject matter which historically has qualified as a trademark or service mark.

The United States Trademark Association Review Commission Report and Recommendations to USTA President and Board of Directors, 77 TMR 375, 421 (1987) (Emphasis added.).

The plain language of the Trademark Review Commission's report incorporated into the legislative history of the Trademark Law Revision Act of 1988 states that "***a* color**" which functions as a trademark is not precluded from registration. The article "a", in its ordinary meaning, means "one." *Webster's New World Dictionary* 1 (2nd College Ed. 1979). The Commission in reviewing and making its recommendations regarding Section 45 of the Lanham Act determined: "[t]hat some of the definitions are



unclear and anachronistic or not in keeping with preferable judicial interpretation." 77 TMR 375, 419 (1987). In order to solve this problem, Congress clarified and broadened the definition of the term "trademark" in the Trademark Law Revision Act of 1988 on at least two occasions:

> The definition of a trademark is also revised to **broaden** it to reflect contemporary marketing practices and to clarify a trademark's function of distinguishing the goods of one person from those of another. **The revised definition *purposely* retains [ ] (iv) the words 'symbol or device' so as not to preclude the registration of colors**, shapes, smells, sounds or configurations **where they function as trademarks**.

133 Cong. Rec. S16,553 (daily ed. Nov. 19, 1987) (Emphasis added. Remarks on the Introduction of S. 1883 by Sen. DeConcini.).

> The definition of "trademark" is **broadened** to reflect contemporary marketing practices and to make clear a trademark's function of distinguishing the goods of one person from those of another. **The revised definition *intentionally* retains [ ] (iv) the words 'symbol or device' so as not to preclude the registration of colors, shapes, sounds** or configurations **where they function as trademarks**.

S. Rep. No. 515, 2d Sess. 44 (1988).

Congress, by adopting the Trademark Review Commission's recommendations, has already decided the issue now before this Court, namely, "whether the Lanham Act precludes the registration of color as a trademark." The revised definition of the term "trademark" in 15 U.S.C. § 1127 ***purposefully*** and ***intentionally*** retains

the words 'symbol or device' so as not to preclude the registration of a color *alone* where it functions as a trademark. Congress' answer is unequivocal: the Lanham Act does not preclude the registration of *a* color *alone* when it functions as a trademark.

## III. THE LANHAM ACT SHOULD NOT BE INTERPRETED TO PRECLUDE THE REGISTRATION OF A COLOR *ALONE* IN ORDER NOT TO IMPEDE GLOBAL HARMONIZATION EFFORTS AND IN ORDER NOT TO PLACE AMERICAN BUSINESS AT A DISADVANTAGE WITH RESPECT TO THEIR FOREIGN COUNTERPARTS.

Presently in Europe there is a huge effort on the part of the member states of the European Union, namely, France, Germany, Great Britain, Spain, Italy, Belgium, The Netherlands, Luxembourg, Portugal, Denmark, Ireland and Greece, to harmonize their laws in order to establish a Community trademark. The Community trademark is a unitary registration covering the entire territory of the European Union. It is expected to come into operation late in 1995 or early in 1996. Elzaburu, Madrid, *The Community Trademark and Seat in Alicante*, 5 (1994). Since Community legislation has not, for the time being, contemplated in detail the subject of color, any finding by this Court that color *alone* is not protected under the Lanham Act could impede global harmonization efforts on this issue.

The adoption of a Community trademark requires the harmonization of the trademark laws of the member states so that registered trademarks can enjoy parity



under the national laws of the varying member states. The plan for a Community trademark is embodied in the form of Regulation No. 40/94 (EC) of the Council of the European Union dated December 20, 1993. This Regulation was adopted by the Council of the European Union on March 15, 1994. However, full harmonization has not yet been achieved. Several member states are still waiting for their respective Parliaments to pass trademark laws needed to effect the harmonization process. *Id.* at 4.

The definition of the term "trademark" under the Lanham Act is currently consistent with the definition of the "Community trademark." A decision by this Court limiting the definition of a trademark under the Lanham Act will make the United States' definition unduly narrow. Article 1, paragraph 1 of the Regulation defines the Community trademark as:

> A trade mark for goods or services which is registered in accordance with the conditions contained in this regulation and in the manner herein provided.

37 J.O. Comm. Eur. (No. L11) 3 (1994). In defining the term "Community trademark" Article 4 of the Regulation declares:

> A Community trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

*Id.* The language of Article 4 includes any sign capable of distinguishing the goods or services of one undertaking from those of another undertaking. Article 1 and Article 4 do not **exclude** color *alone* from the definition of a Community trademark.

Further, Article 7 of the Regulation does not list a color *alone* as non-registrable subject matter:

**Absolute grounds for refusal.**

1. The following shall not be registered;

a) signs which do not conform to the requirements of Article 4;

b) trade marks which are devoid of any distinctive character;

c) trade marks which consist exclusively of signs or indications which may serve in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services;

d) trade marks which consist exclusively of signs or indication which have become customary in the current language or in the bona fide and established practices of the trade;

e) signs which consist exclusively of:

(i) the shape which results from the nature of the goods themselves; or

(ii) the shape of goods which is necessary to obtain a technical result, or



(iii) the shape which gives substantial value to the goods;

f) trade marks which are contrary to the public policy or to accepted principles of morality;

g) trade marks which are of such a nature as to receive the public, for instance as to the nature, quality or geographical origin of the goods or services;

h) trade marks which have not been authorized by the competent authorities and are to be refused pursuant to Article 6ter of the Paris Convention;

i) trade marks which include badges, emblems or escutcheons other than those covered by Article 6ter of the Paris Convention and which are of particular public interest, unless the consent of the appropriate authorities to their registration has been given.

2. Paragraph 1 shall apply notwithstanding that the grounds for non-registrability obtain in only part of the Community.

3. Paragraph 1(b), (c) and (d) shall not apply if the trade mark has become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it.

*Id.* at 4. The definition of the term "trademark" under the Lanham Act is currently consistent with the definition of a Community trademark. Global harmonization should not be impeded by an unduly narrow construction of the definition of the term "trademark" under the Lanham Act.

As provided by Article 5 Section 1(b) of the Regulation, nationals of other states which are parties to the Paris Convention may be proprietors of Community trademarks. Since the United States is a member of the Paris Convention, U.S. companies will be able to take advantage of the Community trademark. One benefit under the Community trademark system is that an applicant can claim the priority of an earlier national or international trademark. With respect to the issue of "priority," Article 31 of the Regulation states:

> The right of priority shall have the effect that the date of priority shall count as the date of filing of the Community trade mark application for the purpose of establishing which rights take precedence.

*Id.* at 10. If this court holds that the Lanham Act prohibits the registration of color alone where it functions as a trademark, not only will global harmonization efforts be impeded, but U.S. companies will not be able to take advantage of this provision in international competition.

By way of example, in implementing the provision of the European Directive on the harmonization of trademark laws, the United Kingdom broadened its definition of a trademark. The United Kingdom Trademark Law now defines a trademark as any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings. Marks & Clerk, *The Trade Marks Act 1994, A Client Guide*, 2 (1994). **Lackenbach Siegel has been advised that in the United Kingdom: "Trade marks may now include three-dimension marks, sounds, smells,**



**slogans, packaging or colours" – providing such are represented graphically.** Potts, Kerr & Co., *New Legislation: U.K. Trade Marks Act, 1994 Effective Date: Monday, 31 October 1994*, 1 (1994). Since the Regulation on harmonization does not, on its face, prohibit registration of color *alone*, an English company could obtain a color registration in the United Kingdom, file for a Community trademark and get the benefit of its national filing date. A U.S. company would not be entitled to the same benefit of priority for a color trademark application if this Court interprets the Lanham Act to preclude the registrability of color *alone* where it functions as a trade mark. A U.S. company would clearly be at a disadvantage against counterparts in those countries allowing the registration of color alone as regards Community trademarks filed on the basis of an earlier national trademark. A U.S. company could be precluded from the European Common Market based on a prior registration for color *alone* granted to a foreign company even if the American company had prior use.

It is respectfully submitted that this honorable Court take judicial notice of the fact that Section 44(d)[3] of the Lanham Act and the Paris Convention permit foreign

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[3] 15 U.S.C. Section 1126(d) states in relevant part "An application for registration of a mark under section 1, 3, 4, 23, or 44(e) of this Act, filed by a person described in subsection (b) of this section who has previously duly filed an application for registration of the same mark in one of the countries described in subsection (b) of this section shall be accorded the same force and effect as would be accorded to the same application if filed in the United States on the same date on which the application was first filed in such foreign country."

companies that want to protect their trademarks in the United States to get the benefit of earlier filed dates from their respective countries when they file in the United States. The reverse is equally true. This is yet another example which evidences a strong trend towards global harmonization in trademark law. If this court affirms the Ninth Circuit's decision, and upholds the proposition that the Lanham Act prohibits the registration of color *alone* when it functions as a trademark, it will give an inconsistent message to the rest of the world.

An interpretation of the Lanham Act as precluding the registration of a color alone as a trademark will place U.S. Companies at a disadvantage vis a vis their international competitors in international trade, and impede global trademark law harmonization efforts.

## IV. A SINGLE COLOR *ALONE*, SERVING TO IDENTIFY AND DISTINGUISH THE GOODS OF ONE PARTY FROM GOODS MANUFACTURED AND SOLD BY OTHERS, IS NO DIFFERENT THAN A WORD OR DESIGN TRADEMARK, AND THUS SHOULD NOT BE PROHIBITED FROM REGISTRATION UNDER THE LANHAM ACT.

A single color *alone* serves to identify and distinguish the goods of one manufacturer from those manufactured or sold by others, and indicates the source of the goods. Assume one is in the hand tool industry and that all of the manufacturers, A through Z, manufacture a particular type of hand tool from a similar unfinished metal. Assuming there are no distinctive markings on the hand tools and there is no distinctive packaging, consumers



cannot identify and distinguish the goods of one manufacturer from the goods of another manufacturer; all of the tools are the color of the unfinished metal.

Assume that manufacturer A decides to paint his entire hand tool a specific shade of purple to identify and distinguish his goods from the goods of the other manufacturers and to indicate the source of the goods. In this scenario, the specific shade of purple functions as a trademark by identifying and distinguishing manufacturer A's goods from those of the other manufacturers of hand tools and related goods in the marketplace. Of course, manufacturer B is then free to color his entire hand tool green to indicate the source of his goods and distinguish his goods from manufacturer A's goods and other manufacturers' goods. Similarly, the other manufacturers are free to choose a color trademark to identify and distinguish their goods from the goods of manufacturers A and B. Moreover, manufacturers A' through Z' are free to enter this market, and free to choose other colors to identify and distinguish their respective goods. In this scenario, a color *alone* functions as a trademark.

The most recent decision issued by the Federal Circuit on the issue of a color trademark in *Brunswick Corp. v. British Seagull Ltd.*, 32 U.S.P.Q. 2d 1120 (Fed. Cir. 1994) is fully consistent with this rationale. In that case the color "black" did not function as a trademark as applied to boat engines. There the Federal Circuit stated that, "if the use of color on the applicant's goods serves *a non-trademark purpose* that hinders competition, the de jure functionality doctrine precludes trademark protection." *Id.* at 1123. (Emphasis added.). If another arbitrary and distinctive color, e.g. "magenta," was the subject of the

litigation, the Court would certainly have held that the color "magenta" alone functions as a trademark no differently than other "coined" word trademarks, and would be entitled to registration. *In re Owens-Corning Fiberglass Corp.*, 774 F.2d 1116, 1123 (Fed. Cir. 1985) ("We conclude that OCF's use of the color "pink" performs no non-trademark function, and is consistent with the commercial and public purposes of trademarks.").

A color, just as a word, can be "coined" creating an arbitrary and highly distinctive trademark. For example, any manufacturer above can enter a home center store paint department and "coin" a single color *alone* that will serve to identify and distinguish his hand tools from the other manufacturers. An arbitrary and distinctive "custom" color can be created simply by blending a variety of different pigments to get the color desired. This process of "coining" a color is no different than creating an arbitrary and distinctive "coined" word trademark. That is, the trademark TAC can have any combination of letters added to it to make it more arbitrary or distinctive, e.g. TACG, BTAC, BTACD, bTacF, etc. Analogously, pigments are added to a base in a multiplicity of combinations and concentrations to create arbitrary and distinctive single color trademarks. Hence, even the "magenta" color trademark referenced above can undergo a large number of permutations. If one considers the number of colors in the visible spectrum multiplied by the number of permutations each color can undergo, the number of arbitrary and distinctive marks that can be created is truly a very large number.

A single color can be "coined," so as to identify and distinguish the goods of one manufacturer from another.



A color *alone* functioning as a trademark is no different than a word or design mark functioning as a trademark.

## V. THE EXISTENCE OF AT LEAST TEN MILLION DISTINGUISHABLE AND ARBITRARY COLORS INVALIDATES THE COLOR DEPLETION THEORY AND THUS THE COLOR DEPLETION THEORY CANNOT SERVE AS A BASIS FOR PROHIBITING THE REGISTRATION OF COLOR *ALONE* UNDER THE LANHAM ACT.

The color depletion theory cannot serve as a basis for prohibiting the registration of color *alone* under the Lanham Act. There are over ten million colors that are distinguishable by the human eye as discussed below. Within this group of ten million colors, current technology provides several thousand colors to function as trademarks in hundreds of thousands of categories of goods as diverse as shampoos and cat foods.

The colors we perceive in an object are determined by the nature of light reflected from the object. A body which reflects light that is relatively balanced in all visible wavelengths appears white to the observer. On the other hand, a body which favors reflectance in a limited range of the visible spectrum will exhibit variations or shades of color. By way of example, green objects reflect light with wavelengths in the 500 to 570 nm range, while absorbing most of the energy at other wavelengths. Gonzalez & Wintz, *Digital Image Processing* 171 (1983).

Experts estimate that the available number of color variations distinguishable by the human eye exceeds ten million.[4]

These color variations include commercially available colors as well as custom colors. The Pantone, Inc. system of color and the Munsell system of color are universally used in the printing, advertising, and packaging industries. The Pantone system includes over 3000 commercially available process colors and over 7,200 commercially available metallic colors, and the Munsell Color System includes over 1,605 commercially available colors.[5] The Munsell Color System identifies color in terms of three readily quantifiable attributes: hue, value, and chroma. These attributes of a specific color trademark can be expressed mathematically in a three dimensional color space. Macbeth Division of Kollmorgen Instruments Corporation, Munsell Color, 2 (July, 1990).

The color depletion theory is based on the faulty premise that the number of colors that can function as trademarks in the overall color palette is very limited.

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[4] Henry, *Right Hat, Wrong Peg: In re Owens-Corning Fiberglass Corp. and the Demise of the Mere Color Rule*, 76 Trademark Reporter 389, 402 (September – October 1986) ("Hundreds of color pigments are manufactured and thousands of colors can be obtained by mixing hues with each other and by mixing them with white or with black, and white and black (grey).").

[5] It is also reported that even in 1959 at a time when color technology was not as well developed as it is today, there were at least 7,500 distinct color names. VISCC-NBS Method of Designating Colors and a Dictionary of Color Names (National Bureau Standards Circular 553, Government Printing Office 1959).



The color depletion theory states that if a manufacturer were allowed to claim the exclusive right to use a certain color as a trademark, the remaining colors available for use as trademarks would be so few that new entrants would be restrained from entering the marketplace. As stated by the Seventh Circuit: "It is likely, however, that if each of the competitors presently in the tabletop sweetener market were permitted to appropriate a particular color for its product, new entrants would be deterred from entering the market. The essential purpose of trademark law is to prevent confusion, not to bar new entrants into the market." *See, e.g., NutraSweet Co. v. Stadt Corp.*, 917 F.2d 1024, 1028 (7th Cir. 1990).

The rationale of the Circuits prohibiting the protection of color *alone* as a trademark is anachronistic. The rationale fails to consider that the technological progress of the last several decades related to color processing technology has resulted in the creation of a myriad of several thousand colors that can function as trademarks. Hence, several thousand colors are available to manufacturers in each industry for the respective industry's particular type of goods. These thousands of commercially available colors can be further "coined" by altering their respective physical, visually perceptible properties. For example, the simple addition of three visually perceptible attributes, namely, a metallic attribute, a glossy attribute, and a matte attribute, to a group of colors further increases the multiplicity of colors available to function as trademarks. By way of example, a manufacturer can register a specific shade of metallic green to identify and distinguish baby bottles in a particular class. Another manufacturer can register a shade of matte turquoise

color to identify and distinguish clothes pins in another class. American companies are using these technologies in designing new trademarks and in contemporary marketing practices that include, by way of example, the addition of pigment to fiberglass. *See, e.g., In re Owens Corning Fiberglas Corp.*, 774 F.2d 1116 (Fed. Cir. 1985).

Congress in enacting The Trademark Law Revision Act of 1988 clearly did consider these contemporary marketing practices: "The definition of a trademark is also revised to broaden it to reflect contemporary marketing practices and to clarify a trademark's function of distinguishing the goods of one person from those of another." 133 Cong. Rec. S16,553 (daily ed. Nov. 19, 1987) (Remarks on the Introduction of S. 1883 by Sen. DeConcini.). Certainly contemporary marketing practices have utilized advances in technology in the use of color *alone* to distinguish the goods of one person from those of another, notwithstanding the faulty underpinnings of the color depletion theory.

## VI. THE ISSUE OF LIKELIHOOD OF CONFUSION IS NO DIFFERENT THAN THE ISSUE OF SHADE CONFUSION, THUS THE SHADE CONFUSION THEORY CANNOT SERVE AS A BASIS FOR PROHIBITING THE REGISTRATION OF COLOR *ALONE* UNDER THE LANHAM ACT.

The shade confusion theory cannot serve as a basis for prohibiting the registration of color *alone* when it functions as a trademark under the Lanham Act on the grounds that the shade confusion analysis is no different than a standard likelihood of confusion analysis. One of the major concerns expressed by the lower courts with



regard to protection of color *alone* as a trademark is that "trademark infringement suits would soon denigrate into questions of shade confusion" that the judiciary is ill-equipped to resolve. *NutraSweet Co. v. Stadt Corp.*, 917 F.2d 1024, 1027 (7th Cir. 1990); *W.H. Brady Co. v. Lem Products, Inc.*, 659 F.Supp. 1355, 3 U.S.P.Q.2d 1258 (N.D.Ill. 1987).

In reality, the issue of shade confusion is no different than the issue of likelihood of confusion. As stated by the Court of Appeals for the Federal Circuit: "deciding likelihood of confusion among color shades . . . is no more difficult or subtle than deciding likelihood of confusion where word marks are involved." *In re Owens-Corning Fiberglas Corp.* 774 F2d 1116, 1123 (Fed. Cir. 1985). The response to the shade confusion argument is that "likelihood of confusion" decisions must be made as a matter of course in every trademark infringement case. Schmidt, *Creating Protectable Trademarks*, 81 TMR 285, 289 (1991).

By way of example, the Patent and Trademark Office and the district courts have routinely conducted a likelihood of confusion analysis with respect to the registrability and enforceability of color alone when it functions as a trademark. *Wire Rope Corp. of America Inc. v. Secalt S.A.*, 196 U.S.P.Q. 312 (TTAB 1977); *Olay Co. v. Cococar Products, Inc.*, 218 U.S.P.Q. 1028 (S.D.N.Y. 1983), *aff'd*, 742 F.2d 1439 (2d Cir. 1984). The Court in the *Olay Company* case granted plaintiff injunctive relief requiring defendant to employ: "A discernibly different pink, at least 40 percent different in terms of PMS tones." *Olay Co. v. Cococar Products, Inc.*, 218 U.S.P.Q. at 1045. The example demonstrates that the district courts can easily conduct a

likelihood of confusion analysis where color *alone* functions as a trademark, and grant appropriate relief.

In fact, the likelihood of confusion analysis is easier to make when two colors that function as trademarks are at issue than where two designs or word marks are being compared. In making likelihood of confusion determinations involving **word or design** marks, the test involves a two step analysis:

> Comparing word marks or design marks generally involves a two step process of first comparing the marks for similarities in appearance, sound, connotation, and commercial impression. *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366 (7th Cir. 1976). Then, the respective goods are compared to determine if they are related. If the marks are similar and the goods are related, confusion as to source of origin is likely.

Lupo, *The Pink Panther Sings the Blues: Is Color Capable of Trademark Protection?*, 1 Fed. Cir. B. J. 47, 75 (1991). In doing a likelihood of confusion analysis for word marks during the trademark registration process or litigation, it is the perception of the consumer, court, expert witness, attorney, examiner, or combination thereof, that is relied on in determining whether two marks are similar. The same holds true in a likelihood of confusion analysis with regard to color trademarks, except that a court or a party would further have the benefit of the results of a quantifiable scientific comparison of the two color trademarks at issue. By way of example, the system of color notation developed by A.H. Munsell, as referenced above, identifies a color in terms of three quantifiable variables: hue, value and chroma. This method of color notation



arranges the three attributes of color into orderly scales. The scales are used as parameters for the accurate specification and description of color under standard conditions. Macbeth Division of Kollmorgen Instruments Corporation, Munsell Color, 2 (July, 1990). Each of these parameters characteristic of the color trademarks at issue are tabulated, and compared. In fact, technology has progressed to the point where computer hardware and software enables experts to specify match and compare colors:

> First, the human eye is physically capable of distinguishing thousands, if not millions, of colors. Second, a straightforward algorithm is available for keeping track of these numerous shades.

Ebert, *Trademark Protection in Color: Do it by the Numbers!*, 84 TMR 379, 403 (1994). Combined with the advances in computer technology and "color matching," shade confusion analysis is facilitated by quantifiable scientific data.

In sum, the test for shade confusion is no different than the test for likelihood of confusion. The shade confusion analysis is a normal part of the trademark procurement and litigation process. A scientific comparison of the colors for similarity, either by color experts or computer "color matching," facilitates the likelihood of confusion analysis. The shade confusion theory cannot serve as a basis for prohibiting the registration of color *alone* under the Lanham Act.

## CONCLUSION

In view of the foregoing, the decision of the Ninth Circuit denying the registration of a color *alone* where it functions as a trademark should be reversed.

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